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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,267	07/18/2003	Darrell James Monnie	115171-003	3505

7590 10/04/2005  
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EXAMINER

HARVEY, DIONNE

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 10/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/623,267

Applicant(s)

MONNIE ET AL.

Examiner

Dionne N. Harvey

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 8-15, 26, 27, 29, 31, 32 and 34 is/are pending in the application.
- 4a) Of the above claim(s) 5-7, 16-25, 28, 30, 33 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 8-15, 26, 27, 29, 31 and 32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/15/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

Group I, illustrated in **figure 4** and described in **claims 1-4,8-15,26,27,29,31,32 and 34**;

Group II, illustrated in **figure 6** and described in **claims 7,16,17 and 18**;

Group III, illustrated in **figure 7** and described in **claims 6,24,25,30 and 35**;

Group IV, illustrated in **figure 8** and described in **claims 5,19-23,28 and 33**;

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. **Currently, Group I is generic.**

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Attorney R. Smith on 9/27/2005 a provisional election was made without traverse to prosecute the invention of Group I **claims 1-4,8-15,26,27,29,31,32 and 34**. Affirmation of this election must be made by applicant in replying to this Office action. **Claims 5-7, 16-25, 28, 30, 33 and 35** are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims **1-3,8-12,26,27,29,31,32 and 34** are rejected under 35 U.S.C. 102(b) as being anticipated by **Mickelson (US 6,229,901)**.

*Regarding claim 1,*

Mickelson teaches, in figure 1, a device for use in conjunction with a mount and an ear of a user, comprising: *(absent specific claim language drawn to the structural detail of the “sound receiver”)*, figure 4 teaches a vocal sound receiver (20); a sound director (11) coupled to the sound receiver (20); and an ear sound deliverer (15) coupled to the sound director (11).

*Regarding claim 2,*

Mickelson teaches that the sound receiver, deliverer and director are entirely mechanical.

*Regarding claim 3,*

Mickelson teaches that the sound deliverer (15) includes a head engagement member (16).

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*Regarding claim 8,*

Mickelson teaches a sound guide (12) having an outer perimeter edge, said edge being interpreted as reading on “a vocal sound receiver” defining an opening, as claimed;

In figures 3A and 3B, Mickelson further teaches a sound director (11) having, as shown in figure 2, a *distal end*, defined as that end nearest the mouth of the wearer, and wherein said distal end reads on “first tubular portion” coupled to the sound receiver (12) and having at least one bend (see the arcuate surface which is illustrated in figures 3A-3B);

A *proximate end*, defined by that end which is nearest to the ear of the wearer, and reading on “a third tubular portion”;

And a *middle portion*, disposed between said *distal* and *proximate* ends, said *middle portion* reading on “a second tubular portion”, as claimed;

an ear sound deliverer (15) coupled to the third tubular portion i.e., *proximate end* and defining at least one opening (see the C-shaped configuration),

the ear sound deliverer (15) having a head engagement member (*the c-shaped configuration of member-15 engages the ear of the wearer*);

and at least one head securing member (16) coupled to the sound director (11).

*Regarding claim 9,*

in figure 4, Mickelson teaches that the sound director (11) is a one-piece member.

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*Regarding claim 10,*

Mickelson teaches that the sound receiver, deliverer and director are entirely mechanical.

*Regarding claim 11,*

Mickelson teaches that the head engagement member (see the c-shaped configuration of unit-15) has an open center portion, which encompasses the ear of the vocalist.

*Regarding claim 12,*

Mickelson teaches that the head securing member includes an elongated head portion engagement member, see headband (16).

*Regarding claims 26 and 31,*

Mickelson teaches a method comprising:

Enabling a vocalist to secure a device to a head portion of the vocalist via headband member (16);

Using a first portion (see portion of sound guide (12), which is nearest the mouth of the wearer) to receive the vocal sound from the vocalist;

Using a second portion (see portion of sound guide (12), which is nearest the ear of the wearer) to direct a portion of the vocal sounds toward a third portion (15) of the device;

And using the third portion (15) of the device, to direct the vocal sounds to the ear of the vocalist.

*Regarding claims 27 and 32,*

Mickelson teaches the step of providing a "unitary" device, which includes the first, second and third portions.

*Regarding claims 29 and 34,*

Mickelson teaches enabling the vocalist to adapt the device via adjustment mechanism (18) for delivering the vocal sound to both ears of the user, which reads on "the right ear or left ear" of the user.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4 and 13-15** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Mickelson (US 6,229,901)** in view of **Bronnikov (US 2002/0131616)**.

*Regarding claims 4 and 13-15,*

Mickelson teaches a device for placement over a wearer's ears, wherein at least one head securing member (16) *adjustably* attaches to the sound receiver, sound director and sound deliverer.

Mickelson does not teach that the head securing member is removably attached or that the device has an interchangeable left-ear/right-ear orientation.



In figure 4, Bronnikov teaches a device for placement over a wearer's ear, wherein the head securing member (404,406) is removably attached to that portion of the device which delivers sound to the ear of the wearer, and further has an interchangeable left-ear/right-ear orientation.

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Mickelson and Bronnikov, constructing the device of Mickelson such that the head securing member is detachable from the sound directing components, thus permitting a greater freedom of use of the device such as in situations where it is necessary for one ear of the wearer to be uncovered, for example, if the user wishes to take a phone call, without removing the device. It also would have been obvious for one of ordinary skill in the art at the time of the invention to construct the device such that it has an interchangeable left-ear/right-ear orientation, thereby permitting the user to wear the device on that side which is most comfortable, as is well known and understood in the art.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

**Wilton (US 6,130,953)** teaches a headset.

**Lee (US 4,930,148)** teaches a headband with adjustable left-ear/right-ear configuration.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne N. Harvey whose telephone number is 571-272-7497. The examiner can normally be reached on 9-5:30 M-F.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dionne Harvey



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PRIMARY EXAMINER